

REMARKS

In the application claims 1-41 remain pending. No claims have been cancelled and no further claims have been added. Claim 26 has been amended to add a period at the end of the sentence as requested in the Office Action.

In the Office Action claims 1-41 were rejected under 35 U.S.C. § 103 as being rendered obvious by the combination of Darbee (commonly assigned U.S. Patent No. 4,959,810) in combination with Teskey (U.S. Patent No. 6,747,568).

In response to this rejection of the claims it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that the references being relied upon disclose the claimed invention “as a whole,” i.e., each and every element considering each and every word. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. In other words, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is additionally submitted that to be “inherently” described in a prior art reference, the prior art reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991).

With these requirements for maintaining a rejection under 35 U.S.C. § 103 in mind, it is respectfully submitted that neither Darbee nor Tesky disclose, teach, or suggest, expressly or inherently, whether considered alone or in combination, each and every word set forth in the claims under consideration. For this reason it is respectfully submitted that the rejection of the claims must be withdrawn.

The claimed invention is directed to systems and methods for monitoring for the successful transmission of a command code sequence, commonly referred to as a “macro” within the art. As described in the subject application for patent, the transmission of a command code sequence is used to cause the performance of multiple operations by one or more appliances, e.g., to power on all appliances of a home entertainment center, to access pay-per-view events via a set-top box, etc. However, owing to the length of typical command code sequences, it is not uncommon for one or more of the command codes within the sequence to fail to reach the intended target appliance(s). The failure to successfully transmit all of the command codes from the remote control to the appliance(s) may arise from the user pointing the remote control away from the appliance(s) during the transmission of the sequence, from the transmission of the sequence being temporarily interrupted by a passing person, etc. Accordingly, the claimed invention provides systems and methods that function to signal a remote control and/or inform a

remote control user that a transmitted sequence of command codes was not properly received by the appliance(s) to, among other things, allow the remote control and/or user to ensure that the home entertainment center is placed into the desired state.

Turning now to Darbee, it is respectfully submitted that passages from within Darbee relied upon in the rejection of the claims are simply not concerned with the monitoring of a transmission of a sequence of command codes, i.e., a macro. In particular, at Col. 2, lines 39-40 Darbee discloses a method for setting up a remote control which includes learning a command code from another remote control. To this end, Darbee discloses receiving a transmission of a train of pulses from a remote control transmitter which is then associated with a function key of the remote control. Since some remote controls are known to transmit the same command code in repetition when a key is depressed, Darbee further describes that, when learning a remote control command, it is advantageous to determine whether or not a repetition of the train of pulses occurs (which signifies a repeated transmission of the command code) and, if a command code is repeatedly received, ignoring the repetition of the train of pulses when storing the learned command code for use in the remote control. What Darbee does not describe within the cited passage, however, is the claimed “determining if the transmission from a remote control includes all of the command codes in a command code sequence.” Not only is Darbee completely silent as to this claim element, it is also respectfully submitted that determining if a repetition exists in a signal to be learned (which requires an *inclusion* of the repeating pattern) cannot be said to disclose, teach, or suggest determining if there exists an *omission* in a sequence of command codes received from a remote control as is claimed.

While cited Col. 2, lines 39-54 of Darbee is directed to one method for setting up a remote control to command operations of an appliance, Col. 13, line 58-Col. 14, line 16 relied

upon in the rejection of the claims is directed to another method for setting up a remote control to command operations of an appliance. More particularly, Col. 13, line 58-Col. 14, line 16 describes a method for setting up a remote control to command an appliance in which command codes from different command code sets for appliances manufactured by different manufacturers that are pre-stored in the memory of the remote control are transmitted to an appliance until such time as the equipment responds. When the appliance does respond to a transmitted command code, the user may cause the command code set that includes the command code that caused the appliance to respond to be used within the remote control to command that appliance. This described method for configuring a remote control by transmitting commands to the appliance does not, however, include the appliance actively determining if a transmission from the remote control includes all of the command codes in a sequence of command codes as is set forth in the claims. Rather, as will be appreciated, the appliance that receives the command codes is passive and either responds to the receipt of a transmitted command code or it does not in keeping with its normal operation.

From the foregoing it will be appreciated that the two different methods for setting up a universal remote control to command operations of an appliance that are disclosed within Darbee fail to disclose, teach, or suggest the base elements set forth in the claims which are directed to systems and method for monitoring for the successful transmission of a sequence of command codes. In addition, since these methods for setting up a universal remote control to command operations of an appliance are completely unrelated (even within the text of Darbee), they are not properly combinable for the purpose of deprecating the invention claimed. For at least this reason the rejection of the claims must be withdrawn.

Turning now to Teskey, Teskey, like Darbee, discloses a method for setting up a universal remote control to command operations of an appliance. More particularly, Col. 6, lines 51-54 of Teskey relied upon in the rejection of the claims, discloses the exact same method that was disclosed within Darbee, namely, a method in which command codes from different command code sets for appliances manufactured by different manufacturers that are pre-stored in the memory of the remote control are transmitted to an appliance until such time as the equipment responds. Again, like Darbee, when the appliance does respond to a transmitted command code, the user may cause the command code set that includes the command code that caused the appliance to respond to be used within the remote control to command that appliance. If the appliance does not respond to a transmitted command code the user simply causes the remote control to transmit another, different command code (“another signal format”) to the appliance. Thus, like the method disclosed within Darbee, the Teskey described method for setting up a remote control by transmitting commands to the appliance does not include the appliance actively determining if a transmission from the remote control includes all of the command codes in a sequence of command codes as is set forth in the claims. Teskey also fails to describe that an action is performed by the appliance for the purpose of initiating a retransmission of command signal(s) when it is determined that one or command codes are missing from a command code sequence. Rather, as will be appreciated, the appliance that receives the command codes is passive and either responds to the receipt of a transmitted command code or it does not (i.e., no action is performed by the appliance if an inappropriate command code is transmitted by the remote control) in keeping with its normal operation. Based upon these facts, it is respectfully submitted that, even if Darbee where to include the base elements of the invention claimed (which it does not), nothing from Teskey could be said to

suggest modifying Darbee to arrive at the invention claimed. For at least this reason the rejection of the claims must be withdrawn.

From the foregoing, it is evident that the combination of Darbee and Teskey fails to present a *prima facie* case of obviousness. More particularly, Darbee and Teskey, whether considered alone or in combination, fail to disclose each and every element set forth in the claims and are not even relevant to the problem the subject invention addresses. Accordingly, the rejection of the independent claims must be withdrawn.

As concerns the rejection of claim 5 (and any claims setting forth similar elements), it is respectfully submitted that relied upon Col. 14, lines 35-39 of Darbee, which sets forth “if you try all of the codes in the device library and your equipment does not respond, it is probably because the code data for generating the infrared codes for operating your equipment is not in the library of your control device,” cannot be said to disclose, teach, or suggest sending a signal to the remote control to cause the remote control to retransmit at least those command codes in the sequence of command codes determined to be missing. In fact, the cited passage fails to describe the transmission to or receipt by the remote control of any signal for any purpose. Accordingly, it is requested that the rejection of claim 5 be withdrawn.

As concerns the rejection of claims 6 and 7 (and any claims setting forth similar elements), it is respectfully submitted that the disclosure within relied upon Col. 14, lines 22-26 of Darbee, which sets forth a method of activating DO keys to transmit commands to an appliance for the purpose of setting up the remote control, cannot be said to expressly or inherently describe the subject matter set forth in either claims 6 or 7. In this regard, the relied upon passage fails to make clear that the missing descriptive matter of “the signal [sent to the remote control] comprises data indicative of command codes within the sequence of command

codes determined to be missing from the sequence of command codes” is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill in the art and, as such, cannot be said to inherently describe that which is set forth in claim 6. It is also evident that the relied upon passage fails to expressly describe that which is set forth in claim 7, i.e., the passage does not describe the transmission of a signal to the remote control let alone one which comprises command codes within the sequence of command codes determined to be missing from the sequence of command codes as is claimed. Accordingly, since Darbee fails to expressly or inherently describe that which is set forth in claims 6 or 7, the rejection of claim 6 and the rejection of claim 7 must be withdrawn.

With respect to the rejection of claim 8 (and any claims setting forth similar elements), it is respectfully submitted that Col. 14, lines 31-34 of Darbee relied upon in the rejection of the claims, which sets forth “if your equipment is responding to your device (i.e., remote control) but some buttons are causing the wrong thing to happen, keep going...” simply fails to expressly or inherently describe transmitting a signal to a secondary device to cause the secondary device to retransmit at least those command codes in the sequence of command codes determined to be missing from the sequence. In this regard, the cited passage fails to mention a secondary device, a secondary device transmitting signals, etc. For this reason the rejection of claim 8 must be withdrawn.

With respect to the rejection of claims 15 and 16 (and any claims setting forth similar elements), it is respectfully submitted that the disclosure at Col. 2, lines 34-38 of Darbee, directed to a remote control being taught commands from another remote control, does not disclose, teach, or suggest *a command receiver* (i.e., a device having programming for determining if the transmission from a remote control included all of the command codes in a

sequence of command codes as is claimed) that is adapted to learn or receive via download a sequence of command codes. Accordingly the rejection of claims 15 and 16 must be withdrawn.

With respect to the rejection of claim 18 (and any claims setting forth similar elements), Col. 1, lines 9-16 of Darbee relied upon in the rejection which describes a universal remote control that transmits commands to appliances as is conventional, does not disclose, teach, or suggest a *command receiver* (i.e., a device having programming for determining if the transmission from a remote control included all of the command codes in a sequence of command codes as is claimed) that is integrated into an appliance. Accordingly the rejection of claim 18 must be withdrawn.

With respect to the rejection of claims 19 and 20 (and any claims setting forth similar elements), it is respectfully submitted that Col. 14, lines 27-34 of Darbee relied upon in the rejection, which describes operation of the DO keys to restore the DO keys to normal functions after the remote control has been set up, fails to disclose, teach, or suggest a *command receiver* (i.e., a device having programming for determining if the transmission from a remote control included all of the command codes in a sequence of command codes as is claimed) that is adapted to prevent or cause the performance of operations of a home appliance corresponding to the sequence of command codes until such time as or when it is determined that all or less than all of the command codes within the sequence have been received, respectively. In this regard, the cited passage makes no mention of anything receiving commands transmitted from a remote control let alone a sequence of command codes, determining anything, or preventing or causing anything. Accordingly the rejection of claims 19 and 20 must be withdrawn.

As concerns the rejection of claim 27 (and any claims setting forth similar elements), it is respectfully submitted that no disclosure has been cited that discloses, teaches, or suggest the

claimed command receiver being programmed such that the command receiver confirms and acknowledges the receipt of a command code with the remote control and wherein the remote control waits for the acknowledgement before transmitting the next command code in a sequence. Accordingly the rejection of claim 27 must be withdrawn.

As concerns the rejection of claim 29 (and any claims setting forth similar elements), it is respectfully submitted that no disclosure has been cited that discloses, teaches, or suggest a command receiver which receives and stores a sequence of command codes which is then available to compare against future transmission received from a remote control to allow the command receiver to determine if the future transmission comprises the stored sequence. Accordingly the rejection of claim 29 must be withdrawn.

As concerns the rejection of claims 31 and 32 (and any claims setting forth similar elements), it is respectfully submitted that Col. 2, lines 34-38 of Darbee relied upon in the rejection of the claims, which describe a learning, universal remote control, fails to make clear that the missing descriptive matter of transmitting a label and storing a label associated with a sequence of command codes is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill in the art and, as such, cannot be said to inherently describe that which is set forth in claims 31 and 32, i.e., no label is described and a label need not be transmitted for a remote control to learn commands from another remote control. Accordingly the rejection of claims 31 and 32 must be withdrawn.

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined,

however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

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Respectfully Submitted;

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